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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/837,301 04/11/97 STEVEN

A 14014.0327

EXAMINER

HM12/0802

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ART UNIT

PAPER NUMBER

1641

12

DATE MAILED:

08/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/837,301

Applicant(s)

Alasdair C. Steven

Examiner

Lisa V. Cook

Group Art Unit

1641



☒ Responsive to communication(s) filed on May 4, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 57-97 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 57-97 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

Amendment

1. In response to Applicant's Amendment-A, filed 5/4/00 (paper #11) -claims 1-56 have been canceled without prejudice. The previous Election/Restriction of claims 1-56 is **MOOT** in light of applicants' cancellation of the claims. The newly submitted claims 57-97 are directed to an invention that is independent or distinct from the invention originally claimed. New claims 57-97 have been added to more particularly define the invention and are newly restricted below:

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 57-67 (*previously claims 37-42 of Group IV*), are drawn to a composition containing a T4 surface lattice protein, classified in class 536, subclass 24.1 or class 536, subclass 25.3. Product
 - II. Claims 68-78 and 96, are drawn to a method of making the composition of claim 57, classified in class 436, subclass 89. Method of Making
 - III. Claims 79-89 and 97, are drawn to second method of making the composition of claim 57, classified in class 435, subclass 69.1. Method of Making
 - IV. Claims 90-95, are drawn to a methods of immunizing or treating a mammal with an antigenic composition, classified in class 424, subclass 184.1. Method of Use

3. The inventions are distinct, each from the other because of the following reasons:

Inventions (II – III) and I are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product of Group I can be made by either the process according to Group II or the process of Group III. Because two materially different processes can produce the product, restriction is proper.

Inventions I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptide of Group V can be utilized as a reagent in inhibition assays, in nucleic acid hybridization assays, or detection of an organism. Further, as exemplified in Group IV, the antigenic polypeptide composition is not only useful in immunization but could be employed to produce specific antibodies or direct expression of a polypeptide in a mammalian host.

Inventions II, III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case each of the method Groups are patentably distinct because Group I is

drawn to a method of making a composition in which a polypeptide is displayed via protein binding while, Group II is drawn to a method of making a composition in which the polypeptide is displayed via binding of a virion and nucleic acid sequence encoding the polypeptide of interest. The method of Group III is additionally distinct because it is drawn to mammalian immunization and treatment. These methods all utilize different reagents, have different method steps, and detect different events.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Please note that the classifications in the restriction are illustrative only and **do not** represent all the classes and subclasses which must be searched for each invention; nor is the search limited to issued US patents, but rather includes foreign patents and applications as well as literature searches.

5. A telephone call was made to Gwendolyn Spratt on 7/24/00 to request an oral election to the above restriction requirement, but did not result in an election being made.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

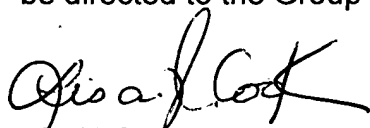
7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).


8. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO fax center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Group 1641 Fax number is (703) 308-4242 which is able to receive transmissions 24 hours/day, 7 days/week.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa V. Cook whose telephone number is (703) 305-0808. The examiner can normally be reached on Monday - Friday from 7:00 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, can be reached on (703) 305-3399.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.


Lisa V. Cook
Patent Examiner
CM1-7D16


LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600